

REMARKS

Claims 1-8 are pending in this application. Claims 1 and 2 are amended solely to improve readability (claim 1) and to correct a typographical error (claim 2). No new matter is being added.

The Examiner rejected claims 1-8 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, and also rejected claims 1-8 under 35 U.S.C. 112, second paragraph, as being indefinite.

This application is a continuation of U.S. Patent No. 6,183,362 (the '362 patent), which is a continuation of U.S. Patent No. 5,761,647 (the '647 patent). Both the '362 and the '647 patents are the subject of litigation currently pending before the United States Court of Appeals for the Federal Circuit (case 05-1144; -1145). Briefs have been submitted to the Federal Circuit, and oral argument is scheduled for November 10, 2005. Appeal was taken from a judgment of the United States District Court for the District of Nevada in which the lower court found that "to the extent that the Plaintiffs' patents-in-suit contain the limitation of theoretical win profile, they are invalid due to indefiniteness." The court also found that "the term theoretical win profile is indefinite," and "[a]ccordingly, the written description is inadequate as a matter of law."

Because this application is a continuation of, and shares the written description of, both the '362 and '647 patents, and because the Examiner's rejections under 35 U.S.C. paragraphs 1 and 2 mirror the findings of the District Court in the litigation now pending, Applicant's response to the Examiner's rejection is essentially the same as Harrah's Entertainment's (the Assignee of the present application) position in the pending Federal Circuit appeal. To that end, Applicant attaches as an Appendix to this Amendment a copy of the briefs filed in the Federal Circuit, both by Harrah's and by Station Casinos. In addition, Applicant provides the following Remarks, traversing the Examiner's rejections.

The Examiner argues that the originally filed specification (which is essentially identical to the disclosure of the '647 patent) fails to provide adequate written description for a customer's theoretical win profile, including either a formula, method or algorithm. Further, the Examiner argues that the claimed

invention is indefinite with respect to how to determine a customer's theoretical win profile from betting activity, for the same reason. Lastly, the Examiner asserts that a customer's theoretical win profile is an improper functional limitation.

The term "theoretical win profile" is not indefinite, and is supported by the written description.

First, the phrase "theoretical win profile" appears in the original '647 patent specification, and in the originally filed claims of that application, thus providing literal written description support for the term. *Union Oil Co. of Cal. V. Atlantic Richfield Co.*, 208 F.3d 989, 998 n.4 (Fed. Cir. 2000)("[D]isclosure in an originally filed claim satisfies the written description requirement."); *See also In re Gardner*, 480 F.2d 879, 879-80 (C.C.P.A. 1973)("[W]e consider the original claim in itself adequate 'written description' of the claimed invention.").

Next, the term "theoretical win" was well known in the art at the time of invention as an estimate of a casino's winnings from a customer's bets. Further, a "profile" is, according to the Random House Dictionary of the English Language, 2nd Ed., 1987, "a verbal, arithmetical, or graphic summary or analysis of the history, status, etc., of a process, activity, relationship, or set of characteristics: ... *a profile of national consumer spending....*" (emphasis in original). Logically, then, a "theoretical win profile" is a summary or analysis of estimates of a casino's winnings from a customer's betting activity over a period of time, such as an hour, day or trip. Accordingly, since the component words of the phrase "theoretical win profile" have well-recognized meanings, the phrase is not indefinite. *Bancorp Servs., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372 (Fed. Cir. 2004). Further, that the term "theoretical win profile" has a broad definition does not render it indefinite. *See, e.g., SmithKline Beecham Corp. v. Apotex Corp.*, 365 F.3d 1306, 1315 (Fed. Cir. 2004).

The Examiner's contention that "theoretical win profile" is indefinite because it is a functional limitation is also incorrect. The Examiner relies on *MDS Assocs. Ltd. Pshp. v. United States*, 37 Fed. Cl. 611 (1997), which is inapposite. *MDS* describes a fact pattern in which no means could be found in the written description of the patent to provide support for a means-plus-function claim

under 35 U.S.C. 112, ¶6. *Id.* at 625. See also *In re Donaldson Co.*, 16 F.3d 1189 (Fed. Cir. 1994). In the instant application, no pending claims include a means-plus-function limitation.

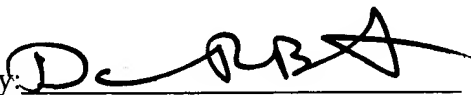
A functional limitation is one which defines something by what it does, rather than by what it is. See, e.g., *In re Swinehart*, 439 F.2d 210, 212 (C.C.P.A. 1971). In the pending method claims, the theoretical win profile appears in steps calling for such specific acts as "updating a theoretical win profile of the customer as a function of the betting activity" (claim 1); "receiving ... a request ... for a customer's theoretical win profile" (claim 2); etc. Likewise, the system claims include specific structure, such as computer systems and databases, including a "local database storing accounts for a portion of the plurality of customers, each account associated with a customer and theoretical win profile generated as a function of betting activity of the customer collected automatically at any of the plurality of casino properties" (claim 7). Accordingly, "theoretical win profile" is not functional.

Even if the term were functional, which it is not, "there is no support, either in the actual holdings of prior cases or in the statute, for the proposition, put forward here, that 'functional' language, in and of itself, renders a claim improper." *Id.* at 213; see also *In re Roberts*, 470 F.2d 1399, 1402-03 (C.C.P.A. 1973).

In view of the above amendments and remarks, the Examiner is asked to withdraw his rejections and issue a Notice of Allowance allowing all pending claims. The Examiner is also invited to contact the undersigned attorney by telephone to discuss any outstanding matters requiring attention prior to allowance.

Respectfully submitted,
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Date: October 31, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: John Michael Boushy
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TITLE: National Customer Recognition System and Method
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ATTY. DKT. NO.: 19538-05688

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REQUEST FOR SUSPENSION OF ACTION UNDER 37 C.F.R. § 1.103(a)

Pursuant to 37 C.F.R. § 1.103(a), Applicant requests that the Office suspend examination of this application for a period of 6 months. The petition fee required by 37 C.F.R. §1.17(g) is attached.

This application is a continuation of U.S. Patent No. 6,183,362 (the '362 patent), which is a continuation of U.S. Patent No. 5,761,647 (the '647 patent). Both the '362 and the '647 patents are the subject of litigation currently pending before the United States Court of Appeals for the Federal Circuit. Briefs have


been submitted to the Federal Circuit, and oral argument is scheduled for November 10, 2005. Appeal was taken from a judgment of the United States District Court for the District of Nevada in which the lower court found that "to the extent that the Plaintiffs' patents-in-suit contain the limitation of theoretical win profile, they are invalid due to indefiniteness." The court also found that "the term theoretical win profile is indefinite", and "[a]ccordingly, the written description is inadequate as a matter of law."

Because this application is a continuation of, and shares the written description of, both the '362 and '647 patents, and because the Examiner's rejections under 35 U.S.C. paragraphs 1 and 2 mirror the findings of the District Court in the litigation now pending, the validity or invalidity of the pending claims, at least insofar as the instant rejection is concerned, depends upon the Federal Circuit's decision. Given that oral arguments there are imminent, it is hoped that by the time a 6-month suspension of action by the Office expires and the Examiner again takes up the application, a decision will have issued either confirming the basis of the Examiner's rejection or determining that it is incorrect.

Accordingly, the Office is asked to suspend examination for 6 months.

Respectfully submitted,
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